

**REMARKS**

The Applicants thank the Examiner for the thorough examination of the application.

Claims 1-21 are pending in the application. Reconsideration of the Application in view of the following remarks is respectfully requested.

**Rejections under 35 USC §103**

Claims 1-6 and 8-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,229,814 to Hube et al. ("Hube") in view of U.S. Patent 6,850,337 to Anderson et al. ("Anderson"). Applicants respectfully traverse this rejection.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Applicants respectfully submit that Hube does not disclose a number of positively recited features of the claims. For example, Hube does not disclose that the control system selects an eligible tray that can accommodate the required recording sheets. All that Hube does in this regard is to direct the operator to load the requested stock by displaying the message “Load requested stock in available tray” as shown, for example, in Fig. 7B, and as described in col. 9, lines 53-66. Hube simply does not disclose a selection being made by the control system. Any selection is made by the operator, not the control system, as recited.

Moreover, when Hube subsequently receives a stock load acknowledgement in step 328 of Fig. 7B, Hube reverts to steps 306-1 through 316 shown in Fig. 7A, instead of automatically assuming that the installed recording sheets are of the required type or store information specifying the required type of recording sheet in a location of the memory associated with the eligible tray, as claimed.

This is significantly different than what occurs in Applicants’ claimed invention. As

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discussed on page 3 of this Application, in Applicants' claimed invention, the control system selects a specific tray, without leaving any choice to the user. Thus, the control system "knows" which type of recording sheet has been loaded into which tray, and it can appropriately update the contents of the memory automatically. In this way, the process of reloading recording sheets is greatly simplified and sped-up, and the likelihood of input errors is reduced. Hube simply fails to disclose the claimed features and cannot provide this improvement.

In an attempt to remedy the deficiencies of Hube, the Office Action turns to Anderson. However, Anderson does not remedy these deficiencies. While Anderson has a user interface 44 coupled to a controller 30 and configured to provide information to a user and to receive inputs from a user, and a display 46 to provide information about the operation of the printer to a user, and input keys 48 (col. 4, last paragraph), if a print request or a print job cannot be met by the current printer configuration, then the appropriate user can be alerted via step 108 by displaying current configuration data (col. 9, lines 12-23). If physical changes with respect to print media trays 54 are made by a user, they are detected, then at least portions of the current printer configuration status are displayed to the user (col. 9, lines 33-39). However, Anderson neither discloses nor suggests that the control system selects an eligible tray that can accommodate the required recording sheets for a given job. If anything, that is left up to the user/operator in Anderson. Nor does Anderson disclose or suggest that its controller automatically assume that recording sheets installed by a user/operator after the user/operator is informed that a print request or job cannot be met with the current printer configuration, are of the required type. In fact, Anderson actually goes to the trouble of detecting the characteristics of the changes (col. 9, lines 33-39), which it would not need to do if it made that assumption.

So, even if one of ordinary skill in the art were properly motivated to turn to Anderson to modify Hube (which has not been demonstrated to be the case by objective factual evidence), because both references do not disclose or suggest a number of claimed features, the modified version of Hube would not disclose, suggest, or otherwise render obvious, the claimed invention. In other words, neither Hube's nor Anderson's control system selects a specific tray, without leaving any choice to the user, or automatically assumes that the installed recording sheets are of the required type and stores information specifying the required type of recording sheet in a location of the memory associated with said eligible tray.

Furthermore, the Office Action fails to indicate why one of ordinary skill in the art would be motivated to turn to Anderson to modify Hube, as suggested other than to speculate that "it increases the productivity of a printer coupled to one or more computers" citing col. 1, lines 13-16 of Anderson. Applicants respectfully submit that Hube's system already increases productivity of a printer coupled to one or more printers and that this is merely a broad conclusory statement about the teaching of both applied references which, standing alone, is not evidence of proper motivation to modify Hube in view of Anderson, as discussed in the aforementioned "Dembiczak" decision.

Thus, the Office Action fails to make out a prima facie case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 7 stands rejected under 35 USC §103(a) as being unpatentable over Hube in view of Anderson and further in view of U.S. Patent 6,327,051 to Moro et al. ("Moro"). This rejection is respectfully traversed.

The Hube-Anderson reference combination fails to render obvious the invention recited in claim 1, from which claim 7 depends, for reasons discussed above. Moreover, Moro is not applied to remedy the aforementioned deficiencies in the Hube-Anderson reference combination. Accordingly, even if the Hube-Anderson reference combination were modified, as suggested, the modified version of the Hube-Anderson reference combination would not render the claimed invention obvious.

Furthermore, Moro does not appear to disclose a plurality of user terminals. All that Moro's Fig. 10, relied on in the rejection, discloses is a single host computer 100 connected to the user device. So, Moro does not provide proper motivation to one of ordinary skill in the art to modify the Hube-Anderson reference combination to include the recited "at least two user terminals."

Accordingly, the Office Action fails to provide a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

### **CONCLUSION**

Applicants respectfully submit that the Examiner's rejections have been overcome, rendered moot or obviated in view of this Reply. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

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Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

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Respectfully submitted,

By 

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